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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

DAY, HERNG DER

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 06/04/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/284,067

Applicant(s)

HARASAKI ET AL.

Examiner

Herng-der Day

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is in response to Applicants' Submission (paper # 12) to Office Action dated October 7, 2003 (paper # 10), mailed March 8, 2004.

1-1. Claims 68, 70, and 73 have been amended; claims 68-81 are pending.

1-2. Claims 68-81 have been examined and rejected.

Drawings

2. The objection to the drawings has been withdrawn. When the application is allowed, Applicants will be required to submit new formal drawings.

Specification

3. The objections to the specification in paper # 10 have been withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 68-72 and 74-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al., U.S. Patent 5,357,439 issued October 18, 1994, in view of d'Huart, U.S. Patent Des. 345,509 issued March 29, 1994.

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5-1. Regarding claims 68-69, 71-72, and 74-81, Matsuzaki et al. disclose an original product outward design creating method in a design creating system having a consumer terminal (order window, column 5, lines 51-53) and maker-side host computer (design and manufacturing departments, FIG. 1) connected with the consumer terminal through an information communication network, the method comprising steps of:

(Claim 68) providing in the maker-side host computer (design and manufacturing departments, FIG. 1), a product parts digital information indicating product constituent parts (design information, FIG. 1) and a design software (the software supporting the “product specification defining system 1”, including the software supporting the “selective indication inputting means 11”, FIG. 1 and column 6, lines 15-34) to the consumer terminal (order window, column 5, lines 51-53);

receiving in the consumer terminal (order window, column 5, lines 51-53), the product parts digital information indicating product constituent parts (design information, FIG. 1) and the design software (the software supporting the “product specification defining system 1”, including the software supporting the “selective indication inputting means 11”, FIG. 1 and column 6, lines 15-34) from the maker-side host computer (design and manufacturing departments, FIG. 1);

displaying in the consumer terminal, the product constituent parts on a display of the consumer terminal (customer indication input unit 1-1, FIG. 2 and column 6, lines 15-22) by using the design software (the software supporting the “selective indication inputting means 11”, FIG. 1 and column 6, lines 15-34);

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selecting in the consumer terminal, desired product constituent parts from the product constituent parts in accordance with an input from the consumer terminal by using the design software (selective indication inputting means 11, FIG. 1 and column 6, lines 15-34);

creating in the consumer terminal, an original product outward design information (goods specification, FIG. 1) by using the design software to combine the product parts digital information related to the desired product constituent parts (FIG. 8 and corresponding specification);

transmitting from the consumer terminal, the original product outward design information to the maker-side host computer (transmitted, column 12, lines 18-21); and

receiving in the maker-side host computer, the original product outward design information (transmitted, column 12, lines 18-21);

(Claim 69) acquiring in the consumer terminal, production status of a product according to the original product design information (state value, FIG. 1);

(Claim 71) displaying in layers in the consumer terminal, a completed figure, pattern groups of product constituent parts, and designation of parts, on a screen of the consumer terminal by using the design software (FIG. 10);

(Claim 72) sequentially and selectively displaying on a screen of the consumer terminal from a large group to a small group of the product constituent parts by using the design software (the details of the item will be displayed, column 11, line 56, through column 12, line 1);

(Claim 74) displaying in the consumer terminal, a plurality of competed products to be compared with one another on the same screen of the consumer terminal by using the design software (resulting designs, column 11, lines 4-12; FIG. 9);

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(Claim 75) selecting location, number, length, font and color of a dial-plate message on a screen of the consumer terminal by using the design software (graphic processing function, column 9, lines 10-41);

(Claim 76) displaying a plurality of sample patterns on the same screen of the consumer terminal by using the design software (enter into “photo corner” and show samples, FIG. 8);

(Claim 78) inputting in the consumer terminal, message information independently created by the consumer, and wherein the original product design information includes the message information (keyboard, column 9, lines 22-25);

(Claim 79) inputting in the consumer terminal, product design information independently created by the consumer, and wherein the original product design information includes the product design information (enter into “craft corner” and change outer appearance, FIG. 8);

(Claim 80) the original product design information includes material information of the product constituent parts (the attribute includes material, column 16, line 57, through column 17, line 3);

(Claim 81) the original product design information includes mechanical function information of the product constituent parts (the attribute includes strength, column 16, line 57, through column 17, line 3).

Matsuzaki et al. fail to expressly disclose that the “product parts digital information” and the “original product design information” are respectively the “watch parts digital information” and the “original watch design information” indicating watch constituent parts and for creating watch design. Neither do Matsuzaki et al. expressly disclose any inherent information of the original watch design information.

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d'Huart discloses an ornamental design for a wristwatch (d'Huart, claim). In other words, the watch design disclosed by d'Huart indicates what the necessary watch parts digital information indicating watch constituent parts and the original watch design information for creating watch design, such as, watch case information, buckle information, watch band information, hands information, dial-plate information, time indicator information, etc. (Claim 77), will be inherent.

In order to meet the customer's own requirements for a watch and provide a method of implementing the design, selection, and ordering of such a watch, one of ordinary skill in the art of watch making would be motivated to modify the teachings of Matsuzaki et al. to incorporate the inherent watch parts digital information indicates watch constituent parts and the original watch design information for creating watch design as disclosed by d'Huart. In other words, the combined teachings of Matsuzaki et al. and d'Huart enable the clock maker to produce a watch customized to the customer's own specifications.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Matsuzaki et al. to incorporate the teachings of d'Huart to obtain the invention as specified in claims 68-69, 71-72, and 74-81 because it enables the clock maker to produce a watch customized to the customer's own specifications in a highly efficient, commercially practical method.

5-2. Regarding claim 70, Matsuzaki et al. fail to expressly disclose confirming in the maker-side host computer, a color tone of an original design watch according to the original watch design information, although Matsuzaki et al. do provide design information using detail design CAD system based on customer requirement as shown in FIG. 1. Therefore, confirming color

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tone is implicitly provided because the combined teachings of Matsuzaki et al. and d'Huart enable the clock maker to confirm and produce a watch customized to the customer's own specifications which includes color tone.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Matsuzaki et al. to incorporate the teachings of d'Huart to obtain the invention as specified in claim 70, because it enables the clock maker to confirm and produce a watch customized to the customer's own specifications in a highly efficient, commercially practical method.

6. Claims 71-74 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Matsuzaki et al., U.S. Patent 5,357,439 issued October 18, 1994, and d'Huart, U.S. Patent Des. 345,509 issued March 29, 1994 as applied to claim 68, and further in view of Maxey et al., "New Riders' Reference Guide to AutoCAD Release 13", New Riders Publishing, Indianapolis, Indiana, 1995.

6-1. Regarding claims 71-74 and 76, Matsuzaki et al. fail to expressly disclose displaying on a screen of the consumer terminal an enlarged view of an original design watch according to the original design watch information by using the design software. Nevertheless, Matsuzaki et al. suggest using CAD system to provide design information as shown in FIG. 1 and using graphic computer 1-22 which has a graphic processing function (column 9, lines 31-41).

In New Riders' Reference Guide to AutoCAD Release 13, Maxey et al. "document each command, along with every prompt and dialog box feature associated with that command" (introduction, page 2). Specifically, Maxey et al. disclose:

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(Claim 71) displaying in layers in the consumer terminal, a completed figure, pattern groups of watch constituent parts, and designation of parts, on a screen of the consumer terminal by using the design software (LAYER, pages 369-373).

(Claim 72) sequentially and selectively displaying on a screen of the consumer terminal from a large group to a small group of the watch constituent parts by using the design software (DVIEW, pages 277-284).

(Claim 73) displaying on a screen of the consumer terminal an enlarged view of an original design watch according to the original design watch information by using the design software (ZOOM, pages 756-759).

(Claim 74) displaying in the consumer terminal, a plurality of competed watches to be compared with one another on the same screen of the consumer terminal by using the design software (MAKEPREVIEW, pages 401-402).

(Claim 76) displaying a plurality of sample patterns on the same screen of the consumer terminal by using the design software (DVIEW, pages 277-284).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Matsuzaki et al. and d'Huart to incorporate the AutoCAD teachings of Maxey et al. to obtain the invention as specified in claims 71-74 and 76, as suggested by Matsuzaki et al.

Applicants' Arguments

7. Applicants argue the following:

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(1) Claim 70 has been amended to avoid having an insufficient antecedent (page 8, paragraph 2, paper # 12).

(2) “Matsuzaki et al. also does not disclose or suggest the steps in claim 68 of providing the design software to the consumer terminal or receiving the design software in the consumer terminal from the maker-side host computer” (page 9, paragraph 1, paper # 12).

(3) “The customer does not appear to select the parts of the desired product, but inputs the specification for the desired product in contrast to this step” (page 9, paragraph 2, paper # 12).

(4) “Applicants submit the Examiner’s assertion of motivation is conclusionary, at best, without a convincing line of reasoning to support it, and, thus, a prima facie case for obviousness has not been made” (page 9, last paragraph, paper # 12).

(5) “If the Examiner persists with this rejection, he is respectfully requested to identify by page(s) and line(s) where the contents of these claimed steps are specifically disclosed in Maxey et al.” (page 14, paper # 7).

Response to Arguments

8. Applicants’ arguments have been fully considered.

8-1. Applicants’ argument (1) is persuasive. The claim rejections in paper # 10 under 35 U.S.C. 112, second paragraph, for indefiniteness have been withdrawn.

8-2. Applicants’ argument (2) is not persuasive. The software supporting the “product specification defining system 1”, including the software supporting the “selective indication inputting means 11” (Matsuzaki et al., column 6, lines 15-34), meets the limitation of the

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claimed "design software". Matsuzaki et al. also disclose, as described in column 7, lines 29-31, "In FIG. 3, 1-A, 1-B and 1-C respectively denote product specification defining systems installed in the branch offices" and the product specification defining systems are connected to maker-side host computer through network. Providing and receiving software through network is well known in the art.

8-3. Applicants' argument (3) is not persuasive. For example, Matsuzaki et al. disclose, as described in column 7, lines 4-6, "1-10 denotes a combination design unit which designs the product based on the specification required by a customer".

8-4. In response to Applicants' unpersuasive argument (4) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so has been found in the knowledge generally available to one of ordinary skill in the art of watch marketing.

8-5. In response to Applicants' unpersuasive argument (5) against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Reference to Quintero et al., U.S. Patent 5,293,479 issued March 8, 1994, is cited as disclosing a method for preparing parametric assemblies.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Heng-der Day whose telephone number is (703) 305-5269. The Examiner can normally be reached on 9:00 - 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kevin J Teska can be reached on (703) 305-9704. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Heng-der Day
June 1, 2004

Thai Phan
Thai Phan
Patent Examiner
AU: 2128